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Atty Dkt No. GP-302538 (GM-0434PUSP)

**Remarks**

Claims 1-20 are currently pending. Claims 3-5, 7-12 and 14 are withdrawn. Claims 1, 2, 6, 13 and 17 are rejected under 35 U.S.C. § 102(a) as being anticipated by WO 02/45996 (WO '996). Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO '996 in view of United States Patent No. 6,145,919 (Mysliwiec et al.). Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO '996 in view of United States Patent Application Publication No. 2001/0052715 (McAndrew et al.). Claim 20 is objected to as being dependent upon a rejected base claim.

**Examiner's Comment Regarding Withdrawn Claims 10 and 11**

In an effort to expedite prosecution of withdrawn claims 10 and 11, the Examiner indicates that:

After a very cursory review of claims 10 and 11, it appears these claims may not define an embodiment consistent with the base claim. In other words, while the base claim covers multiple ones of the disclosed embodiment, it may not cover or be consistent with the embodiment and details recited in instant claims 10 and 11.

Applicants appreciate the Examiner's remarks, and agree that claims 10 and 11, which are intended to correspond with Figures 12-14, are not consistent with claim 1 as the armrest 110 does not rotate downward. Applicants have amended claims 10 and 11 accordingly.

**Rejections Under Section 102(a) : WO '996**

Claim 1 has been amended to include the limitation that:

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the armrest includes a mounting portion connected to the support portion, wherein the mounting portion is connectable to the vehicle body, wherein the support portion is pivotally mounted to the mounting portion, and wherein the armrest is a module.

Thus, under newly amended claim 1, referring to the embodiment shown in Figures 3-5, the support portion 12 is pivotally mounted to the mounting portion 14. The mounting portion of WO '996, which the Examiner indicates "includes teeth 204 and is mounted at 202" pivots with WO '996's support portion of element 2. Thus, WO '996 does not include a support portion that is "pivotally mounted to the mounting portion" as required by amended claim 1. The Section 102(a) rejection of claim 1, and of claims 2, 6 and 17 which depend therefrom, is believed to be overcome at least for this reason.

Additionally, claim 1 is amended to specify that the armrest is a module. Figures 3 and 5 illustrate armrest module 50. A "module" is commonly defined as, and understood by those of ordinary skill in the automotive arts to be, "a separable component, frequently one that is interchangeable with others, for assembly into units of differing size, complexity, or function." Webster's New Universal Unabridged Dictionary (1996 Random House Value Publishing, Inc.). Neither WO '996 nor Mysliwiec et al. teaches an armrest, including a support portion and a mounting portion, that is a module. The rejections under Section 102(a) are believed to be overcome for this reason as well.

Rejections Under Section 103(a): WO '996 in View of Mysliwiec et al.

Claims 15 and 16 are rejected under Section 103(a) over WO '996 in view of Mysliwiec et al. A *prima facie* case of obviousness requires that the prior art references teach or suggest all claim limitations of the examined claim. (MPEP 2143.03). As discussed above with respect to the rejection of claim 1 under Section 102(a), WO '996 does not teach a support portion that is "pivotally mounted to the mounting portion" as required by amended claim 1.

Because the cited references do not teach or suggest the limitations of newly amended claim 1, the rejection of claims 15 and 16, which depend therefrom, is believed to be overcome.

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Rejections Under Section 103(a) : WO '996 in View of McAndrew et al.

Additionally, with respect to claims 18 and 19, the Examiner admits that WO '996 fails to teach a "support portion [that] has at least one control device for occupant command to the vehicle" and further fails to teach such a control device providing occupant input command for one of the listed functions of claim 19: a window position control, a radio control, a mirror control, a vehicle climate control, a seat adjustment control and an armrest support portion rotation control.

The Examiner finds that :

McAndrew et al. teaches an adjustable armrest system defining an armrest portion which includes a pivotable portion 40. The portion 40 includes at least a mirror control 50.

In order to allow for convenient access to a control device, it would have been obvious to one of ordinary skill in the art to locate at least a mirror control device on the pivotable armrest portion of '996 in view of the teachings of McAndrew et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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As discussed above with respect to the rejections under Section 102(a), WO '996 does not anticipate claim 1. Because claims 18 and 19 depend from claim 1, they are allowable for at least the same reasons that claim 1 is allowable.

Additionally, McAndrew et al.'s mirror control 50, shown in Figure 5, is located on a pivotable door panel 40 rather than on the top surface 38 of the armrest 10, best shown in Figure 1, which is clearly intended to serve as the support portion of armrest 10. McAndrew et al. teach that the mirror control 50 is part of a first bank of controls 44 on panel 40 which, when pivoted open, reveal a second bank of controls 70 (see paragraph [0015]). McAndrew et al. also teach the necessity of a foam pad 89 for preventing inadvertent weight on panel 40 in the event that the panel 40 is depressed downward too far and hits the upper portions of the second bank of controls 70 (see paragraph [0020]). Thus, McAndrew et al. teach away from locating controls on a portion of an armrest that will be subject to generalized weight, such as in the support of an occupant. The MPEP provides that, in establishing a *prima facie* case of obviousness, the prior art must be considered in its entirety, including disclosures that teach away from the claims. MPEP 2141.02. Accordingly, it would not be obvious to one of ordinary skill in the art to locate the mirror control 50 of McAndrew et al. on the support portion 2 of WO '996 in light of the limitations taught by McAndrew et al. with respect to weight placed on panel 40 where mirror control 50 is located.. Additionally, based on the teachings of McAndrew et al., a person of ordinary skill in the art would not have a reasonable expectation of success in placing the mirror control 50 on the support portion 2 of WO '996, as McAndrew et al. teach that generalized weight may cause malfunction of controls. Accordingly, the second element of the *prima facie* case for obviousness is not met.

Applicants submit that the combination of McAndrew et al.'s mirror control 50 and the support portion 2 of WO '996 is done only based on hindsight, using the teachings of the present application. The Federal Circuit makes clear that the best defense against the subtle but powerful attraction of impermissible "hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). See also *Graham*, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for

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piecing together the prior art to defeat patentability – the essence of hindsight. See, e.g., Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”).


Applicants submit that, for at least these reasons as well, the rejection of claims 18 and 19 is improper.

### CONCLUSION

With the amendments to the claims and the arguments presented above, Applicants submit that pending claims 1-20 are in condition for allowance, including withdrawn claims 3-5, 7-12 and 14, as claim 1 is generic.

Respectfully submitted,

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